

## **REMARKS**

### **I. Introduction**

In view of the above amendments and the following remarks, reconsideration of the rejections and objections contained in the Office Action of April 17, 2009 is respectfully requested.

By this amendment claims 5-10, 12-13, and 17-19 have been amended, claims 1-4, 11, and 16 have been cancelled without prejudice or disclaimer to the subject matter contained therein, and claims 20-26 have been added. Claims 5-10, 12-15, and 17-26 are now pending in the application. No new matter has been added by these amendments.

The specification has been reviewed and revised. No new matter has been added by these revisions. Entry of the specification amendments is thus respectfully requested.

### **II. Specification**

Beginning on page 2 of the Office Action, the specification is objected to regarding the format of the abstract. Applicants submit that the substitute abstract included herewith complies with the applicable language and format requirements; withdrawal of this objection is respectfully requested.

### **III. Claim Objections**

On page 3 of the Office Action, claim 4 is objected to regarding the identification of the diameter of the liquid drops with the indication "D2." It is believed that this objection is moot in view of the cancellation of claim 4; further, Applicants submit that new independent claims 21,

25, and 26 correctly identify the diameter in question. Withdrawal of this objection is thus respectfully requested.

#### IV. 35 U.S.C. § 112

Beginning on page 3 of the Office Action, claims 4-14 and 17-19 are rejected as being indefinite. Applicants submit that the above-described claim amendments and cancellations obviate these indefiniteness rejections, and that new claims 21-26 are sufficiently clear and definite. Withdrawal of these rejections is respectfully requested.

#### V. Claim Interpretation

On pages 9-11 of the Office Action, it is asserted that claims 4, 5, 9, 10, 11, and 12 contain intended use statements. Applicants respectfully submit that the recitations in those claims and the corresponding recitations in new claims 20-26 constitute structural or functional limitations which properly limit the claims and should be considered by the Examiner.

Applicants could find no support in the MPEP or applicable case law for the position that a recitation within *the body* of a claim can be considered merely a statement of intended use. Nearly every passage regarding “intended use” in the MPEP explicitly references *the preamble* of a claim. (See MPEP 2111.02, “If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.” See also MPEP 2114, 2111.02, etc.) Moreover, even if a portion of a claim is interpreted as a statement of intended use, the prior art must still be capable of performing the intended use in order to meet the claim. See MPEP 2111.02, as quoted above.

The case law cited by the Examiner on page 11 of the Office Action does not contradict the MPEP in this regard; none of the case law interprets a statement appearing in the body of a claim as an intended use statement. The Finsterwalder precedent refers to an intended use statement which appears in the specification of an application. *In re Finsterwalder*, 58 C.C.P.A. 871, 875 (C.C.P.A. 1971). The Casey precedent specifically describes recitations in the preamble as relating to the “manner or method in which a machine is to be used,” while referring to recitations in the body of the claim as functional limitations. *In re Casey*, 152 U.S.P.Q. 235 (C.C.P.A. 1967) (“We are not persuaded that the board “entirely disregarded” the preamble and functional language as asserted by appellant.”) The Thibault precedent appears to be completely ambiguous to whether the claim language at issue is recited in the preamble or the body of the claim; the apparatus claim is not included in the opinion. *Ex parte Thibault*, 164 USPQ 666 (B.P.A.I. 1969). The Masham precedent addresses the language “for mixing flowing developer material,” which was recited in the preamble of the claim at issue. *Ex Parte Masham*, 2 USPQ2d 1647 (B.P.A.I. 1987).

Applicants submit that claim limitations which appear in the body of a claim, and which “define something by what it does, rather than by what it is” are proper functional limitations, and *must* be considered as required by MPEP 2173.05(g). That section of the MPEP cites the Swinehart precedent, which provides “In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language.... By its own literal terms a claim employing such language covers any and all embodiments which perform the recited function.” *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (C.C.P.A. 1971) (emphasis added). More recent

precedent from the Federal Circuit reaffirms this established point of law. *K-2 Corporation v. Salomon*, 191 F.3d 1356 (Fed. Cir. 1999). In the K-2 case, the Federal Circuit addressed the claim language “for substantially preventing movement therebetween at least in a horizontal plane,” stating that “the functional language requires that the attachment prevent the bootie from sliding around on top of the base; it demands a structural rigidity in the horizontal dimension...” *K-2 Corporation v. Salomon*, 191 F.3d at 1363.

As such, Applicants respectfully submit that the functional recitations in the present application must be considered as provided for in the MPEP and applicable case law. Applicants further submit that if any limitation is interpreted as a statement of intended use, the prior art must nonetheless be *capable of* performing that use in order to meet the claim.

## VI. Prior Art Rejections

Currently, claims 4-5 and 9-13 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Green et al. (US 4,717,049), claims 6-8 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Green et al. in view of Kosaka (US 5,209,978), and claim 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Green et al. in view of Yeo et al. (US 2002/0160109).

Claim 21 is patentable over Green et al., Kosaka, and Yeo et al. for the following reasons. Claim 21 requires a seamless capsule manufacturing device comprising a nozzle for ejecting a liquid for forming capsules, and a flow passage tube configured to contain a hardening liquid for hardening at least a surface part of liquid drops formed from the liquid ejected from said nozzle, wherein said flow passage tube has an inlet part and a deformation section, said deformation

section being arranged downstream of said inlet part, wherein said inlet part is exposed to said nozzle so as to receive the liquid ejected from said nozzle and so as to form the liquid drops in a spherical shape, wherein said deformation section has a cross sectional area smaller than a cross sectional area of said inlet part so as to deform each liquid drop to have an aspheric profile by changing a flow rate of the hardening liquid to expand the liquid drop in a direction of a flow path of the hardening liquid, and wherein said deformation section has an inner periphery configured such that a diameter D1 of a largest circle which fits within said inner periphery of said deformation section is larger than a diameter D0 of the liquid drops in said inlet part.

Greene et al. discloses a droplet generating device having a venturi throat (23) in which liquid droplets are formed. (See figure 2.) In particular, the liquid flows from the end of a capillary tube (19) which is positioned at the most constricted part of the venturi throat (23); the venturi throat thereafter expands in diameter toward the downstream side. (See figure 2.) In contrast, claim 21 requires a deformation section arranged *downstream* of an inlet part, the deformation section having a cross sectional area *smaller than* a cross sectional area of the inlet part. Thus even the structural requirements of claim 21 are not met by the Greene et al. reference. Claim 21 further sets forth functional limitations which are not met by the Green et al. reference. In particular, because Green et al. does not deform each liquid drop to have an aspheric profile by changing a flow rate of the hardening liquid to expand the liquid drop in a direction of a flow path of the hardening liquid, Greene et al. cannot meet the requirements of claim 21. Even if these limitations were to be improperly interpreted as intended use statements, the Greene et al. reference is not capable of performing the functions recited, and thus cannot meet the requirements of claim 21.

The Kosaka and Yeo et al. references are relied upon in the Office Action for disclosures unrelated to the above-discussed deficiencies of Greene et al. Further, Applicants submit that the Kosaka and Yeo et al. references fail to cure the above-discussed deficiencies of Green et al. Moreover, it appears that there would have been no reason to modify any of the prior art of record to yield a configuration which meets the limitations of claim 21. It is thus submitted that the invention of the present application, as defined in claim 21, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claims 5-10, 12-15, 17-20, and 22-24 depend, directly or indirectly, from claim 21 and are thus allowable for at least the reasons set forth above in support of claim 21. New independent claims 25 and 26 are substantially similar to claim 21, and are thus allowable for at least the reasons set forth above in support of claim 21.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, Applicants respectfully submit that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

*The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.*

Respectfully submitted,

Kuniaki YAMANAKA et al.

By: /Andrew D. St.Clair/

Digitally signed by /Andrew D. St.  
Clair/  
DN: cn=/Andrew D. St.Clair/, o, ou,  
email=astclair@wenderoth.com,  
c=US  
Date: 2009.07.17 16:52:21 -04'00'

Andrew D. St.Clair  
Registration No. 58,739  
Attorney for Applicant

ADS/rgf  
Washington, D.C. 20005-1503  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
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